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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,757	09/21/1999	GARY S. HAHN	246/221	3773

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EXAMINER	
WANG, SHENGJUN	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 04/07/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Applicati n No.	Applicant(s)	
	09/400,757	HAHN ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25,52,55,57,58,61-69,77-80,84,85 and 98-114* is/are pending in the application.

4a) Of the above claim(s) *19,20,62-69,77-80,84,85 and 98-114* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18,21-25,52,55,57,58 and 61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Pri rity under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 7/6.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The terminal disclaimer filed on October 3, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 5958436 has been reviewed and is accepted. The terminal disclaimer has been recorded.

2. Receipt of applicants' amendments and remarks submitted April 4, 2003 is acknowledged.

Claim Rejections 35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3, 12, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito et al (U.S. Patent 5,709,849).

3. Ito teaches a cosmetic composition comprising lactic acid, and 0.5% of calcium chloride. See, table 1 in column 3.

Claim Rejections 35 U.S.C.§ 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-18, 21-25, 52, 55, 57, 58 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mishima (5,262153, IDS) in view of Ito (U.S. Patent 5,709,849), Giddey et al. (U.S. Patent 5,053,219), Cook et al. (U.S. Patent 2,719,811) and Henderson (U.S. Patent 5,296,476).

6. Mishima et al. teaches a cosmetic composition comprising mixture of lactic acid and lactate of alkali metal, or alkaline metal with a pH in the range of 2.5-9, wherein the amount of lactic acid and lactate is at least 5% by weight. See, particularly the claims. Calcium lactate is exemplified. See the examples.

7. Mishima et al does not teach expressly the employment of calcium, or the particular amount of the calcium, organic acid, or the particular pH, or the counter anion, or the other known cosmetic ingredients herein.

8. However, Cook et al. teaches that calcium metal with hydroxyl acids are known to be beneficial for skin. See, particularly, column 2, lines 30-40, lines 63-72, and claims 4-5. Henderson teaches that calcium citrate are particularly useful with salicylic acid in topical application. See, particularly the claims. Ito also teaches the usefulness of organic salts of calcium in cosmetic products. See, particularly, the abstract, and the claims. The organic salt

may be produced in situ, i.e., employing an inorganic calcium salt (e.g., calcium chloride) and an organic acid in the cosmetic composition, see, particularly, table 1. Giddey et al. teaches cosmetic composition having an organic acid (0.5-4% by weight) and calcium cation (0.1-1%, by weight).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ calcium lactate in the cosmetic composition with lactic acid, in the amount herein define, and with the pH herein.

A person of ordinary skill in the art would have been motivated to employ calcium lactate in the cosmetic composition with lactic acid, in the amount herein define, and with the pH herein because calcium with hydroxyl acid are particularly known to be beneficial for skin. Further, A person of ordinary skill in the art would have been motivated to employ calcium as the divalent metal in cosmetic composition, wherein a hydroxyl acid is required because calcium with organic acid are known to provide benefit to skin, and calcium cation is particularly known to be useful in some cosmetic product. The employment of other well-known cosmetic or topical ingredients, such as sulfate, nitrate, second anti-irritant agent, steroid, etc, in the topical composition is considered obvious and is with the skill of artisan. Further, optimization within the range disclosed by prior art is obvious and is considered within the skill of artisan.

1. Regarding the functional limitation of the claimed composition, i,e., note it is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior

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art, does not cause a claim drawn to those things to distinguish over the prior art." In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various functional limitation. The ultimate utility for the claimed combination of organic acid and calcium is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Response to the Arguments

Applicants' amendments and remarks submitted April 4, 2003 have been fully considered, but are not persuasive with respects to the rejections set forth above.

Applicants contend that Ito did not discloses irritant ingredients. This is not convincing. Lactic acid employed by Ito is a irritant ingredients. See the claim 13 herein.

Applicants' remarks with respect to the rejections under 35 U.S.C. 103 is moot in view of the new ground rejections.

2. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on October 30, 2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang

March 24, 2004